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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,847	02/16/2001	Jeffrey Specter	S0030/7000	5159
64967 7590 03/09/2007 LAW OFFICES OF PAUL E. KUDIRKA 40 BROAD STREET SUITE 300 BOSTON, MA 02109			EXAMINER CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/785,847	Applicant(s) SPECTER ET AL.	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 7-15, 17-20, 22-30 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-15, 17-20, 22-30 and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This action is responsive to the paper(s) filed 9/8/06.

Claim Rejections - 35 USC § 112

1. Claims 35, 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 35 provides an apparatus claim, yet the claim provides what appear to be method steps rather than structural limitations. Applicant should claim an entity programmed (*or configured or similar*) to accomplish X rather than an entity that performs X. Capability rather than performance of method steps should be set forth.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 2-5, 7-10, 14, 17-20, 22-25, 29, 33-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Paepke (US6249785).

Regarding claims 34-36, 2, 8, 14, 17, 23, 29, 33, Paepke teaches recommending items such as books to users. Paepke notes that prior art methods generally either match similar users and recommend items between them or recommend items based on the popularity of the item [1:37-41]. Paepke provides an approach where user ratings are collected and predictions are made based upon similarities in pairs of ratings. A user who provides ratings for the database is taken to provide "information" identifying a plurality of profile sample items" obtained via a consumer preference test. Figure 16 shows a process for collecting such information and Paepke teaches that the user is presented with a listing of books in the database and that the user may be presented with groups of books [7:64-8:1-10]. Navigating such grouped presentation of books to provide ratings is taken to meet the generation of (ratings) information based upon customer selections. The database includes the ratings for every other user in the system and provides a measurement defined by the distances between each pair of items in the system as in figures 3-6 [4:19-37]. Regarding the claimed distance calculations, the distances of Paepke are calculated as a difference in ratings for each pair of items [4:19-37, figs 3-6], then combined [4:41-58, fig 7]. The database is then used (scanned) in order to locate items to recommend to this user which are most similarly ranked to selected items based on that customer's sample item ratings [8:32-56].

Regarding claims 3, 18, navigating such grouped presentation of books to provide ratings is taken to meet the generation of (ratings) information based upon customer selections as well as receiving item category selections and display of items representing subclasses within each category. The user rates the displayed categorized sample items and the ratings are used as a basis to make predictions [7:64-8:1-10, 23-26].

Regarding claims 4, 5, 19, 20, the methods by which user's rate items are taken to meet the "live audience" language as well as "individually respondent by respondent" language.

Regarding claims 7, 22, Paepke scales each difference to fall within the range of -1 to 1 [3:48-53, fig 2].

Regarding claims 9, 10, 24, 25, 37-39, Paepke teaches that a user may refine the system/recommendations by rating recommendations output to the user [8:54-61].

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 11-13, 15, 26-28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paepke.** Paepke's system is described in terms of ratings and recommendations for books. Paepke states that the system can be used to predict

Art Unit: 3622

items other than books [10:18-20] and also recognizes prior art systems that attempt to recommend books, magazines, movies, plays, music, beer, wine, cigars, restaurants, etc [1:31-36]. It would have been obvious to one of ordinary skill at the time of the invention to have used the system of Paepke in order to rate just about anything including songs, movies, TV shows and fashion.

Response to Arguments

Applicant argues that that he need not claim programmed capability as requested by examiner regarding the 112 P2 rejection. While the examiner in general believes that firmware and special-purpose circuitry both are examples of programming, the point of the rejection was that *capability* to do a function need be structurally present in the claims rather than claims describing *actual performance* (generates, scans, forms, presents, etc are examples of method step performance) of certain steps. Examiner would accept "configured to X" rather than the earlier suggested "programmed for X" as a way to overcome the rejection.

Applicant argues that the similarities in Paepke are related only to the starting point in Paepke's rating system. This even if true does not prevent Paepke from anticipating the present claims. Applicant continues to state that the instant invention uses rating provided by other users. This is also true of Paepke who relies on others' ratings to recommend items to the user. After all without others' opinions a system recommending items to a user solely on his own ratings would be pointless. Applicant argues that no user ratings are used in the recommendation generation. This is false as

Art Unit: 3622

the instant invention clearly collects and relies upon preference ratings from respondents. Further it is noted that applicant is not claiming a lack of user ratings to recommend.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

Art Unit: 3622

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc